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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/450,217 11/29/99 ERDMANN

P 8265-296-999

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EXAMINER
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LUKTON, D	
ART UNIT	PAPER NUMBER

1653

DATE MAILED:

04/27/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/450,217

Applicant(s)

Erdmann

Examiner

David Lukton

Group Art Unit  
1653



☒ Responsive to communication(s) filed on Feb 29, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 DAYS ~~or thirty days~~ or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-22 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

**G1:** the lactic raw material is limited to sweet whey obtained after separation of casein coagulated with rennet, or a concentrate of sweet whey which, optionally, has been demineralized by electrodialysis, ion exchange, reverse osmosis or electrodeionization.

**G2:** the lactic raw material is limited to a concentrate of proteins of substantially lactose-free sweet whey obtained by ultrafiltration, followed by diafiltration, or mother liquors of the crystallization of lactose from sweet whey or a permeate of ultrafiltration of a sweet whey.

**G3:** the lactic raw material is limited to the product of proteolytic hydrolysis of a casein or caseinate obtained by acid precipitation of skimmed milk

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Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-13, drawn to a process wherein the lactic raw material can be whatever the claims permit, including G1, provided that G2 and G3 are excluded, classified in, e.g., 426/41.
2. Claims 1-13, drawn to a process wherein the lactic raw material can be whatever the claims permit, including G2, provided that G1 and G3 are excluded, classified in, e.g., 426/41.
3. Claims 1-13, drawn to a process wherein the lactic raw material can be whatever the claims permit, including G3, provided that G1 and G3 are excluded, classified in, e.g.,

426/41.

4. Claims 14-22, drawn to a caseinoglycomacropeptide obtained by the process of Group 1, classified in, e.g., 424/535.
5. Claims 14-22, drawn to a caseinoglycomacropeptide obtained by the process of Group 2, classified in, e.g., 424/535.
6. Claims 14-22, drawn to a caseinoglycomacropeptide obtained by the process of Group 3, classified in, e.g., 424/535.

The claimed inventions are distinct.

The inventions have been differentiated on the basis of the lactic raw material. Applicants will presumably take the position that a process which employs one raw material will be distinct from (unobvious over) an otherwise identical process which employs a different raw material. However, the possibility of rejoining one or more of the non-elected groups is not necessarily precluded.

Inventions 1-3 and 4-6 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the preparation of the raw material can differ. However, in the event that applicants elect one of Groups 4-6, and claims therein found allowable, the "method-of-

making" claims will be rejoined for further examination [*In re Ochiai* (37 USPQ2d 1127)].

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).


✱

It is noted that claim 2 ends in a comma, rather than a period. This might be just a minor typographical error, or it could be that text was inadvertently omitted. The last two lines of claim 2 are the following; applicants are requested to change the comma to a period, or to provide any additional text that might have been omitted:

"of a micellar casein, obtained by microfiltration of a skimmed milk, the product of hydrolysis of a caseinate by a protease,"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
**DAVID LUKTON**  
**PATENT EXAMINER**  
**GROUP 1800**